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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,960	12/21/2001	Shell S. Simpson	1000-7659-1	5419

22879 7590 07/14/2009
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EXAMINER

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ART UNIT	PAPER NUMBER
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2437

NOTIFICATION DATE	DELIVERY MODE
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07/14/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON and WARD S. FOSTER

Appeal 2008-004390¹
Application 10/029,960
Technology Center 2400

Decided:² July 10, 2009

Before JOHN C. MARTIN, LEE E. BARRETT, and
JAY P. LUCAS, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Hewlett-Packard Development Company.
Br. 2.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1, 5-13, and 17-31, which are all of the pending claims.

We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

A. Appellants' invention

Appellants' invention is a web-based imaging system and method having a distributed architecture for providing electronic notarization services. Specification 1:4-7.

Appellants' Figure 1 is reproduced below.

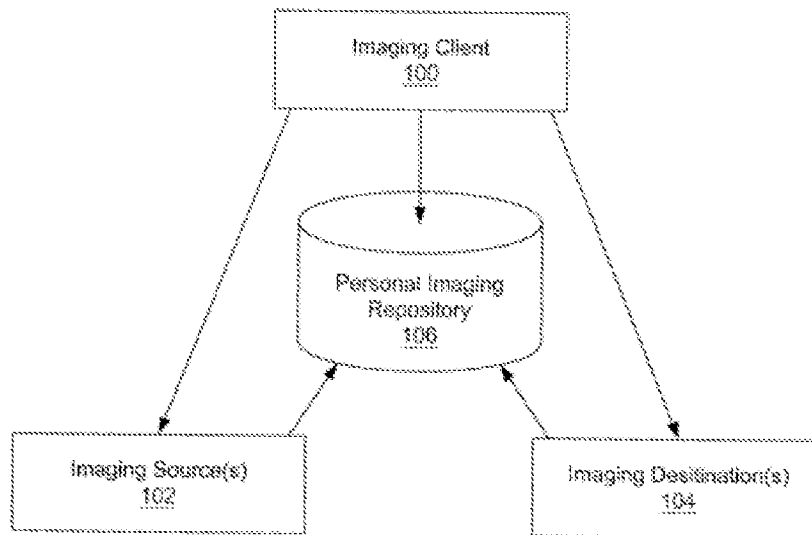


FIG. 1

Figure 1 is a schematic representation of the general operation of the invention. *Id.* at 4:12. As shown in this figure, an imaging client 100 communicates with one or more imaging sources 102, one or more imaging destinations 104, and a personal imaging repository 106. *Id.* at 4:13-15.

The personal imaging repository 106, which provides image storage facilities that typically are personalized for the individual imaging client 100, can be located in various different places. *Id.* at 4:18-20. For example, the repository 106 can be maintained on one or more computing devices associated with the imaging client 100, imaging source(s) 102, or imaging destination(s) 104. *Id.* at 4:20-22. Alternatively, the repository 106 can be maintained on a separate computing device (e.g., server) that the imaging client 100, imaging source(s) 102, and imaging destination(s) 104 can access. *Id.* at 4:22-24.

The imaging data in the imaging repository 106 can be any type of printable data, such as text, graphics, frames of video or animations, pictures, combinations thereof, and so forth. *Id.* at 5:1-3. Once imaging data is stored in the personal imaging repository 106, the imaging client 100 can select data from the repository that is to be communicated to the imaging destination(s) 104 for some form of processing or manipulation. *Id.* at 5:4-6. For instance, the data can be communicated to the image destination(s) 104 for notarization. *Id.* at 5:6-7.

Appellants' Figure 3 is reproduced below.

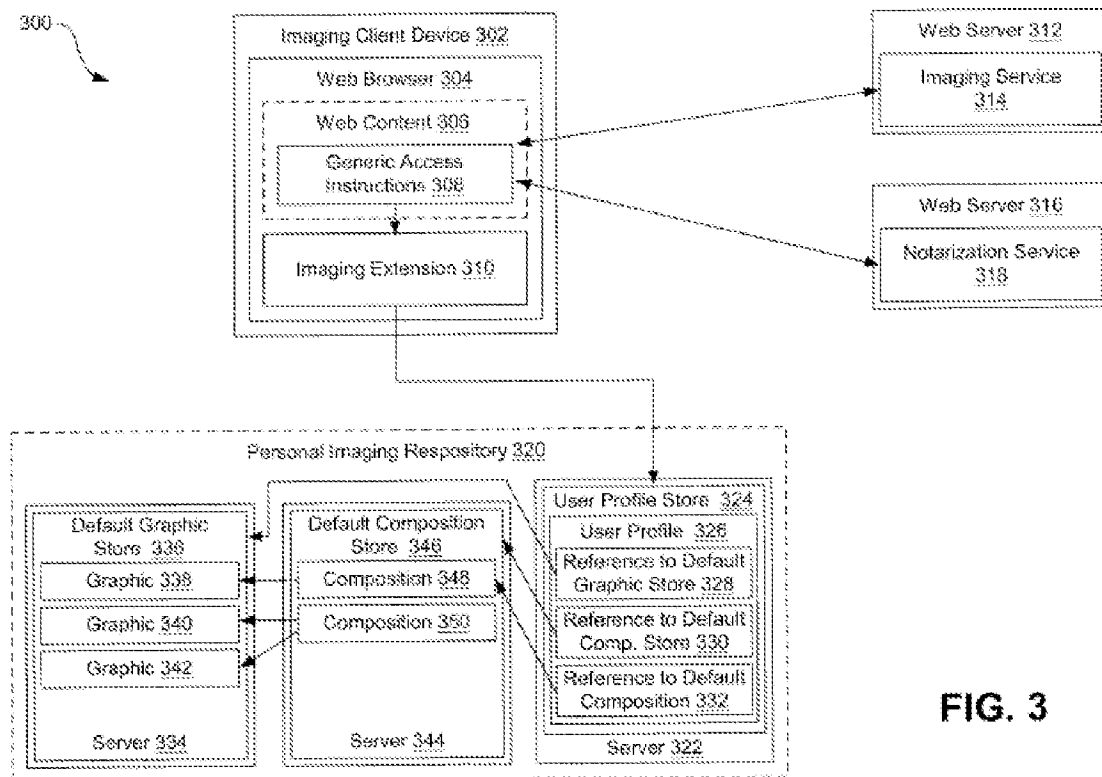


FIG. 3

Figure 3 depicts an example of a web-based imaging system 300 in which the invention can be implemented. *Id.* at 8:3-4.

The imaging client device 302 comprises a web browser 304 that is adapted to access web content 306 derived from an imaging service 314 and notarization service 318 of web servers 312 and 316, respectively. *Id.* at 8:12-15. The web content 306 typically comprises text, graphics, and various commands, which can comprise one or more sets of executable instructions that are downloaded into the browser 304 to perform a service requested by the user. *Id.* at 8:15-18. For example, the web content 306 normally includes executable instructions for causing target graphics, i.e.

graphics provided by an accessed web site, to be displayed to the user. *Id.* at 8:21-23.

The executable instructions are further used to access the personal imaging repository 320. *Id.* at 9:1-2. These instructions typically comprise system-wide generic access instructions 308 that call on methods of an imaging extension 310 to access the personal imaging repository 320 and perform various web imaging operations. *Id.* at 9:2-5. These instructions 308 are designated as “generic” because they are independent of the configuration of the user’s personal imaging repository 320. *Id.* at 9:5-7. The generic access instructions 308 can be used, for example, to add a graphic to a default graphic store 336 of the personal imaging repository 320. *Id.* at 9:7-10.

As is further indicated in Figure 3, imaging extension 310 can form part of the browser 304. *Id.* at 9:11-12. Alternatively, imaging extension 310 can be provided outside of the browser 304, for instance on a different device. *Id.* at 9:12-14. Irrespective of its location, however, the imaging extension 310 is configured to respond to the execution of the generic access instructions 308 by generating/mapping to corresponding imaging client specific commands of the user. *Id.* at 9:14-17. Imaging extension 310 typically is implemented as one or more application programming instructions (APIs) that, preferably, act as interfaces in accordance with a system-wide standard. *Id.* at 9:17-19.

When executed, the generic access instructions 308 cause imaging extension calls (e.g., API calls) to be issued which, in turn, cause the

imaging extension 310 (e.g., APIs) to access to the user's personal imaging repository 320. *Id.* at 9:20-22. The web content 306 thus uses the imaging extension 310 as a gateway to access the user's personal imaging repository 320. *Id.* at 9:22-24.

Notarization service 318 can submit queries to the default graphic store 336 (via the extension 310) as well as request that one or more graphics be transmitted in a desired arrangement to the notarization service. *Id.* at 11:20-24.

B. The claims

The independent claims before us are claims 1, 13, and 21, of which claims 1 and 21 read:

1. A method for notarizing imaging data, comprising:
retrieving imaging data on behalf of a user via a network from the user's personal imaging repository with a network-based notarization service via an imaging extension; and
electronically notarizing the imaging data with the network-based notarization service.

21. A network-based notarization service stored on computer-readable media, comprising:

logic configured to retrieve a document on behalf of a user via an imaging extension, the document being stored in a personal imaging repository of the user; and

logic configured to electronically notarize the document.

Claims App., Br. 23, 26.

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C. The references and rejections

The Examiner relies on the following references:

Schreiber et al. (Schreiber)	US 6,298,446 B1	Oct. 2, 2001
Epstein	US 6,601,172 B1	Jul. 29, 2003
Natarajan	US 6,611,599 B2	Aug. 26, 2003
Braam et al. (Braam)	US 6,957,347 B2	Oct. 18, 2005

Claims 21-23 stand rejected under 35 U.S.C. § 101 for reciting subject matter that is not patent eligible. Answer 7. This is identified as a new ground of rejection in the Answer. *Id.*

Claims 1, 5-13, 17-23, and 29-31 stand rejected under § 102(e) for anticipation by Epstein. *Id.* at 3.

Claims 24 and 25 stand rejected under § 103(a) for obviousness over Epstein in view of Schreiber. *Id.* at 5.

Claims 26 and 27 stand rejected under § 103(a) for obviousness over Epstein in view of Braam. *Id.*

Claim 28 stands rejected under § 103(a) for obviousness over Epstein in view of Natarajan. *Id.* at 6.

Appellants treat the anticipation rejection of independent claims 13 and 21 as standing or falling with the anticipation rejection of claim 1. Br. 15-16.

THE ISSUES

Appellants have the burden on appeal to show reversible error by the Examiner in maintaining the rejections. *See In re Kahn*, 441 F.3d 977, 985-

86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” (citation omitted)).

The issue regarding the § 101 rejection of claim 1 is whether Appellants have shown that the Examiner erred in construing the claim as broad enough to read on an intangible computer-readable medium.

The issues regarding the § 102(e) rejection of the independent claims are whether Appellants have shown that the Examiner erred in finding that Epstein:

(1) discloses “network-based notarization service” “retrieving imaging data on behalf of a user”;

(2) retrieves imaging data from “the user’s personal imaging repository”; and

(3) retrieves imaging data “via an imaging extension.”

Other issues raised with respect to the argued dependent claims rejected under § 102(e) and § 103(a) are also addressed *infra*.

THE § 101 REJECTION

Appellants argue that “presenting the [§ 101] rejection for the first time in the Examiner’s Answer is improper and/or unfairly prejudices Applicant. Applicant therefore respectfully requests that the rejection be overturned.” Reply Br. 3. This request is denied. Appellants’ avenue for avoiding Board consideration of the merits of this new ground of rejection

was to have filed a request under 37 C.F.R. § 41.39(b)(1) to reopen prosecution before the Examiner. Because no such request was filed, the merits of the rejection are properly before us.

A. Principles of law

“If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). “A transitory, propagating signal . . . is not a ‘process, machine, manufacture, or composition of matter’ [under 35 U.S.C. § 101]” and therefore does not constitute patentable subject matter under § 101. *Id.* at 1357.

B. Finding of fact

Appellants’ Specification discloses various tangible examples (e.g., a random access memory) and at least one intangible example (i.e., a “propagation medium”) of the disclosed “computer-readable medium.” Specification 18:13-24.³

³ References herein to the Specification are to the application as filed rather than to the published Application (No. 20030120930).

C. Analysis

The Examiner explained the basis for the rejection as follows:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the mean[ing] of 35 USC §101. They are clearly not a series of steps or acts to be a process no[r] are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. These claims recite that logic is stored on a computer-readable medium, which is defined on page 18 of the specification to include any means to store, communicate, *propagate*, or transport its contents such as an electrical connection. Claims 21-23 are non-statutory because the definition of “computer-readable medium” includes non-statutory subject matter.

Answer 7 (second emphasis added). The Examiner’s mention of Appellants’ disclosed “propagation medium” example suggests that the Examiner has concluded that claim 21 is broad enough to read on the disclosed propagation medium, which under *Nuijten* does not constitute patentable subject matter under § 101.⁴ We do not agree that claim 21 is so broad. In our view, the language “stored on computer-readable media” limits claim 21 to tangible media, with the result that claim 21 recites an article of manufacture and thus constitutes patent eligible subject matter under § 101.

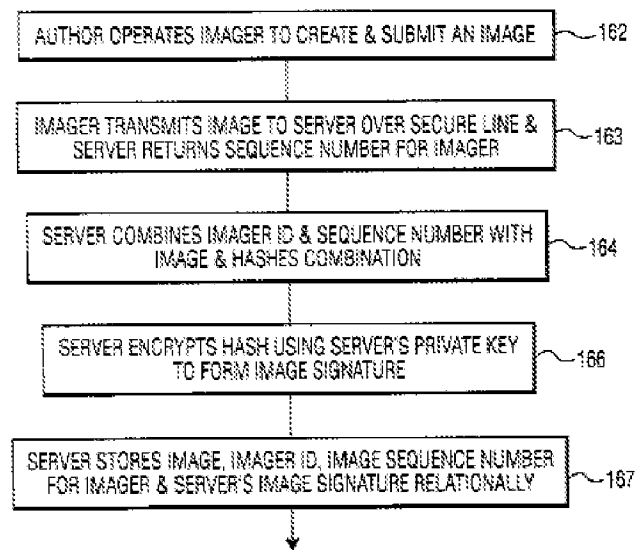
The § 101 rejection of claims 21-23 is therefore reversed.

⁴ The Answer was mailed November 9, 2007. *Nuijten* was decided September 20, 2007.

THE EPSTEIN DISCLOSURE

Epstein discloses methods for notarizing an original document and a revised document so that the relationship between the original document and the revised document can be proved as well as the origination and the time of the revisions notarization. Epstein, col. 1, ll. 50-54.

Figures 2a-d, on which the Examiner specifically relies (Answer 8) and which are reproduced *infra*, show a specific flow chart of one embodiment for authenticating revisions. *Id.* at col. 4, ll. 18-19. Although the Examiner discusses only Figures 2b and 2c, we begin our discussion with Figure 2a, reproduced below.



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FIG. 2A

In the group of steps depicted in Figure 2a, the author creates an image and transfers the image to a server that signs the image for the author and stores the image. *Id.* at col. 4, ll. 19-22. In step 162, the author operates

an imager to create an image (*id.* at col. 4, ll. 22-23), which in step 163 is sent to a server over a secure link. *Id.* at col. 4, ll. 27-28. In the remaining steps, the server uses hashing and encryption techniques to generate a “server’s image signature” that is stored in the server along with the image, an image ID, and an image sequence number. *Id.* at col. 4, ll. 28-40.

Figure 2b is reproduced below.

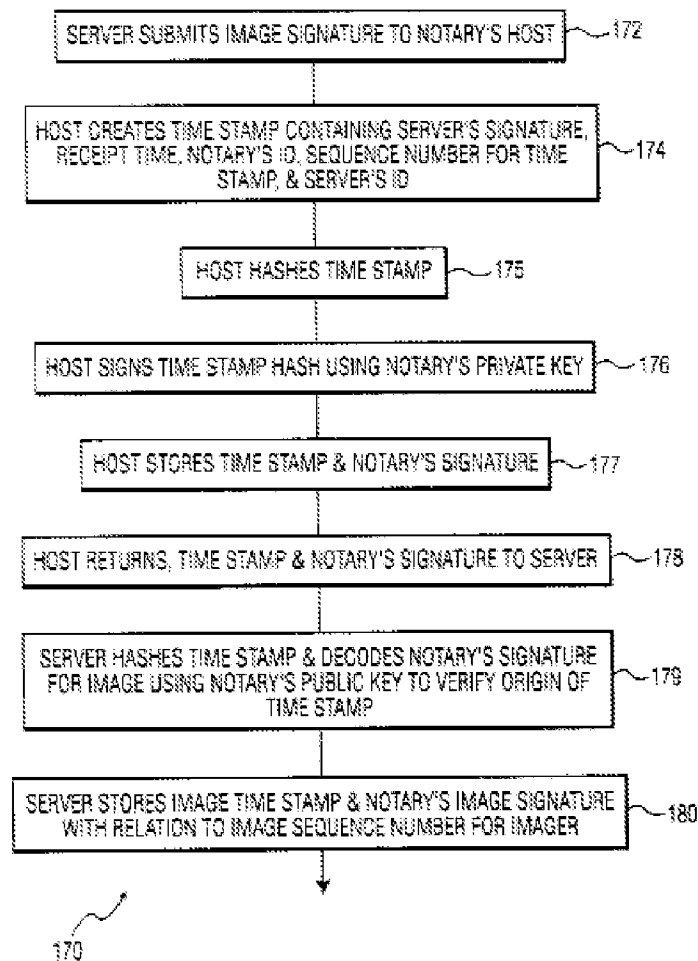


FIG. 2b

In the group of steps depicted in Figure 2b, the server obtains from a notary and stores a time stamp and a time stamp signature. *Id.* at col. 4, ll.

41-43. In step 172, the server establishes a connection with the notary's host and sends the server's image signature to the host. *Id.* at col. 4, ll. 43-45.⁵ In the discussion of the embodiment depicted by Figures 2a-d, Epstein explains that the server can send the author's signature to a notary's host system over the network or the notary can be a secure part of the hardware of the server. *Id.* at col. 3, ll. 8-10. In steps 174-78, the host employs hashing and encryption techniques to generate an image time stamp and a notary's image signature that in step 180 are sent to and stored in the sever. *Id.* at col. 4, ll. 45-57.

Figure 2c is reproduced below.

⁵ Although the Specification attributes these functions to steps 172 and 173, both functions are represented by block 172 (no block 173 is shown).

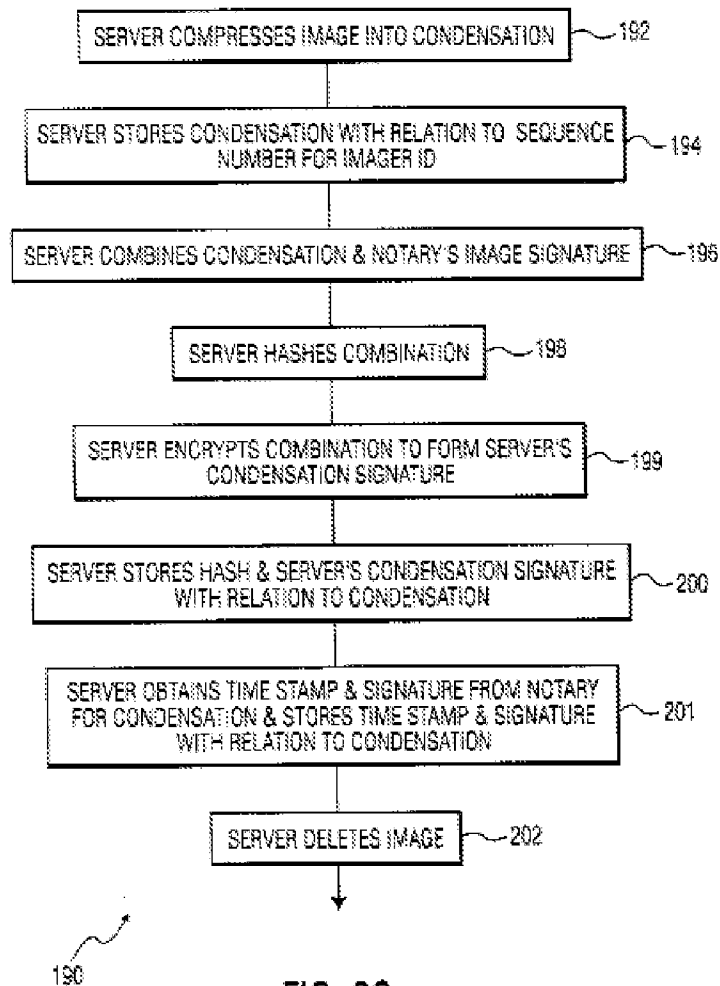


FIG. 2C

In the steps depicted in Figure 2c, the server automatically revises the image by compressing it into a lossy condensation, such as JPEG, and then obtains from the notary and stores a time stamp for the revision. *Id.* at col. 4, l. 58 to col. 5, l. 10. In step 202, the server deletes the image because uncompressed images, especially those of video, may require one hundred times as much storage as compressed video. *Id.* at col. 5, ll. 10-14.

Before addressing Figure 2d, we note that Appellants previously argued that Epstein does not notarize imaging data. *See* Br. 7 (“Epstein’s notary host system does *not* retrieve image data to be notarized. Moreover, Epstein’s notary host system does *not* notarize such image data. Instead, Epstein’s notary host system notarizes *an author’s signature* that is sent to the notary host system from a customer server that received imaging data (a ‘report’) from an author’s workstation.”). The Examiner responded by citing Epstein’s statement that “[i]n the inventions disclosed herein an original document and a revised document are notarized . . .” (Epstein, col. 1, ll. 50-51) and finding that “[i]n the cited portions of columns 4 and 5 the document is the image” (Answer 10). Appellants’ failure to address this position of the Examiner is being treated as a concession that Epstein notarizes imaging data.

Figure 2d is reproduced below.

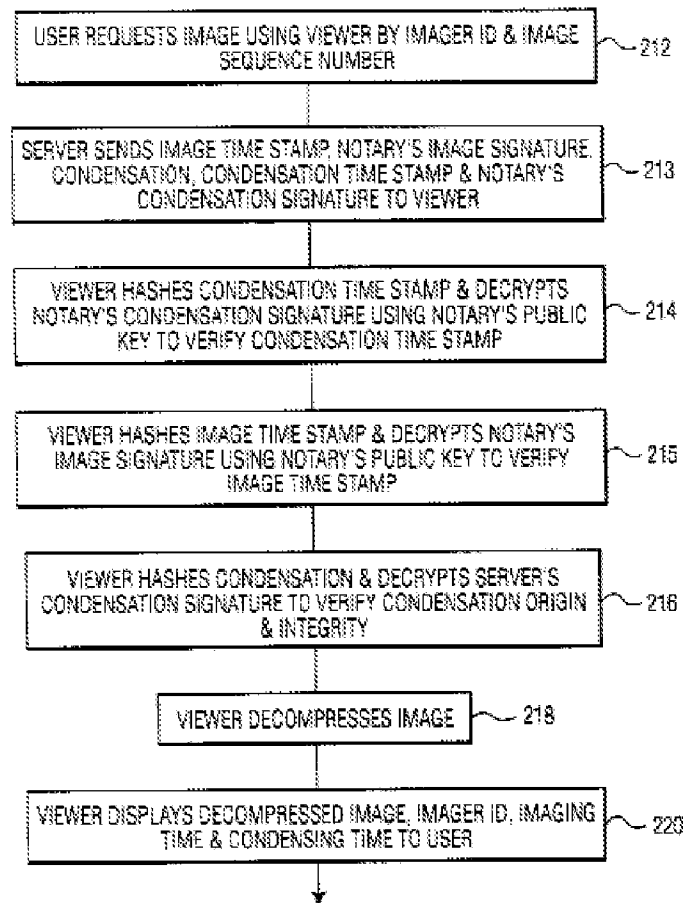


FIG. 2D

In the steps depicted in Figure 2d, a user requests an image for viewing on a viewer and the stored image is provided along with the two time stamps and the two notary's signatures so that the viewer can verify the origin and certification date of the original image and the origin and certification date of the revision. *Id.* at col. 5, ll. 15-21. In step 212, the user requests the image using the viewer, which may be any equipment that allows the image to be played to the user. *Id.* at col. 5, ll. 21-24. In step 213, the server sends the image hash, the imager id, the image condensation,

both related time stamps (one for the image and one for the compressed image), and similarly both notary's signatures to the viewer. *Id.* at col. 5, ll. 26-29. After the viewer performs the processing in steps 214-18, the viewer in step 220 displays the image, imager id, imaging time, and condensing time to the user. *Id.* at col. 5, ll. 30-47.

CLAIM INTERPRETATION

Application claims are interpreted as broadly as is reasonable and consistent with the specification, *In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002), while "taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification," *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), and without reading limitations from examples given in the specification into the claims, *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

The Examiner appears to have concluded that the claims are broad enough to read on retrieving imaging data that has already been notarized:

[t]he portion of Epstein, which anticipates Appellant's claimed invention, is described in columns 4 and 5 referring to figures 2a through 2d. Specifically, the image is notarized in column 4 line 58 through column 5 line 14 and retrieved in column 5 lines 15-21. Therefore, Epstein does retrieve notarized image data.

Answer 8. Appellants have not addressed this claim interpretation in their Reply Brief, let alone demonstrated that the steps must be performed in the recited order, i.e., "retrieving" before "notarizing." *See Baldwin Graphics*

Sys., Inc. v. Siebert, Inc., 512 F.3d 1338, 1345 (Fed. Cir. 2008) (“[A]lthough a method claim necessarily recites the steps of the method in a particular order, as a general rule the claim is not limited to performance of the steps in the order recited, unless the claim explicitly or implicitly requires a specific order.”). We are treating Appellants’ silence as acquiescence in the Examiner’s claim interpretation.

WHETHER EPSTEIN DISCLOSES A “NETWORK-
BASED NOTARIZATION SERVICE” FOR “RETRIEVING
IMAGING DATA ON BEHALF OF A USER”

The Examiner reads the recited “network-based notarization service” on the combination of Epstein’s server, notary (which may be separate from or part of the server⁶), and viewer (Answer 8-9) and explains that “[s]ince the server, notary service and viewer are all part of the system for providing notarized imaging data over a network, Epstein discloses a ‘network-based notarization service’ ‘retrieving imaging data on behalf of a user.’” *Id.* at 9. More particularly, the Examiner found (*id.* at 8) that “Epstein teaches the notarization of imaging data using a server and a notary service, both of [which] are connected to a network, in column 4 line 58 through column 5 line 14” (which addresses Figure 2c) and that “as an additional piece to this network-based notarization service, Epstein discloses a viewer for viewing the notarized images,” citing the discussion of the viewer in column 5,

⁶ Epstein, col. 3, ll. 8-10.

lines 15-17 and 22-29 (which addresses Figure 2d). *Id.* at 8-9. The Examiner further found that the recited “retrieving” step reads on the viewer’s retrieval of imaging data from the server. *Id.* at 9.

In view of the Examiner’s above findings, Appellants are incorrect to argue that “the Examiner has neither identified which entity within that excerpt [from column 4, line 58 to column 5, line 14] is believed to comprise Applicant’s claimed ‘notarization service’ nor identified what action described in the excerpt comprises that service ‘retrieving image data on behalf of a user.’” Reply Br. 5.

Appellants further argue that it is improper to read the “network-based notarization service” on Epstein’s server and notary because “the described ‘server’ is separate from the ‘notary host’ explicitly described by Epstein. *See Epstein*, column 4, lines 41-57.” Reply Br. 6. This argument is unconvincing because Appellants have not explained why the claim term “notarization service,” when given its broadest reasonable interpretation in light of *Appellants’* disclosure, would have been understood to have a meaning that prevents it from being read on Epstein’s notary host in combination with the server and the viewer. We note that “service” is broadly defined in Appellants’ Specification as follows: “As used herein, the term ‘services’ refers to software and/or firmware components that can execute on one or more computing devices and which provide one or more particular functionalities to the imaging client device 202 such as imaging data selection and arrangement, data manipulation, and so forth.” Specification 6:9-12. Epstein’s viewer can be considered to be part of a

notarizing service because the viewer permits a user to retrieve and view an image that has been notarized.

Regarding the Examiner's reading of the "retrieving" step on Epstein's viewer, Appellants also argue that

a teaching of a view is *not* a teaching of a notarization service "retrieving imaging data on behalf of a user" as explicitly recited by Applicant. Unfortunately, the Examiner has . . . declined to provide an explanation of his position. Therefore, he has not identified how the existence of such a viewer is equivalent to a notarization service "retrieving" imaging data "on behalf of a user."

Reply Br. 6. This argument is unpersuasive for the reason stated above, which is that Epstein's viewer can be considered to be part of a notarizing service because it permits a user to retrieve and view a notarized image.

WHETHER EPSTEIN'S SERVER CONSTITUTES THE USER'S PERSONAL IMAGING REPOSITORY

The Examiner found that the recited "user's personal imaging repository" reads on Epstein's server because "it stores all of the imaging data for each user." Answer 9. Appellants assert that "nothing within Epstein's disclosure would lead someone to conclude that the server, which the Examiner previously defined as comprising part of a 'notarization service,' is the user's personal repository for images." Reply Br. 7. As support for this assertion, Appellants make two arguments, neither of which is persuasive. The first is that "Epstein's server is not described by Epstein as a storage place for the user's images. Indeed, . . . Epstein's server *deletes*

the user's images after processing because they take up too much space. *Epstein*, column 5, lines 10-14.” Reply Br. 7. This argument is unpersuasive because it reflects an unduly narrow interpretation of the claim term “imaging data,” which as applied to *Epstein* is not limited to the uncompressed imaging data that is deleted in step 202 in Figure 2c. The claim term “imaging data” is broad enough to read on any data that represents an image, including compressed data.

Appellants' second argument is that it is incorrect to read both the recited “network-based notarization service” and the “user's personal imaging repository” on the server because “[w]ithin the plain and ordinary meaning of the term ‘retrieve’ something cannot ‘retrieve[]’ an entity from itself.” Reply Br. 7. This argument is unpersuasive because Appellants have not explained why the claim terms “network-based notarization service” and “user's personal imaging repository” cannot be read on different parts of *Epstein*'s server (with the “network-based notarization service” further being read on the notary and viewer). Furthermore, *Epstein* explains that imaging data can be stored in and retrieved from archival storage that is separate from the server. *See Epstein*, col. 7, ll. 61-64 (“IOC [input and/or output circuit⁷] 405 is used for storing information onto disk storage 406 and for sending information to archival storage device 407 and occasionally for retrieving the archived information.”).

⁷ *Epstein*, col. 7, l. 55.

WHETHER EPSTEIN RETRIEVES IMAGING
DATA VIA AN IMAGING EXTENSION

As correctly noted by Appellants, “Epstein says absolutely nothing about an ‘imaging extension.’” Reply Br. 7.

The Examiner, citing column 5, lines 19-47, found that because the viewer retrieves the image data from the server and displays the images for the user, “[t]he viewer acts as a gateway to access the user’s personal imaging repository and is therefore an ‘imaging extension.’” Answer 10. The Examiner’s “gateway” language reflects the Specification’s statement that “[t]he web content 306 therefore uses the imaging extension 310 as a gateway to access the user’s personal imaging repository 320.” Specification 9:22-24.

Appellants argue that this position of the Examiner is erroneous for several reasons, none of which is persuasive. One argument is that reading the “imaging extension,” which is recited as part of the “network-based notarization service,” on the *viewer* is inconsistent with the Examiner’s position that the “network-based notarization service” reads on the *server*. This argument is unconvincing because the Examiner instead reads the “network-based notarization service” on the combination of the server, the notary, and the viewer. Answer 8.

Appellants’ next argument is that

as noted above, the Examiner argues that Epstein’s *server* “retrieves” imaging data “on behalf of a user.” See *Examiners Answer*, Section 2(a)(i), pages 8-9. Now, however, the Examiner appears to argue that it is the *user* who “retrieves” the image using Epstein’s “viewer.” First, Applicant submits that the Examiner

cannot point to one entity of Epstein's disclosure as comprising a "notarization service" to account for one limitation and then point to a different entity as comprising that service when accounting for a different limitation. Instead, the Examiner should remain consistent in his position when addressing Applicant's claims.

Reply Br. 8 (first and third emphases added). We do not agree that the Examiner found that the server retrieves the imaging data. Instead, the Examiner found that the viewer retrieves the imaging data from the server. Answer 8-9.

Appellants conclude the above-quoted passage as follows: "Second, the latter argument as to the user retrieving his own images makes no sense given that such a situation clearly would not be a 'notarization service' retrieving the imaging data 'on behalf of a user.'" Reply Br. 8. This argument is unconvincing because, as explained above, Epstein's viewer can be considered to be part of a notarizing service because it permits a user to retrieve and view a notarized image.

Finally, citing page 9, line 11 to page 10, line 24 of the Specification, Appellants assert that "the 'imaging extension' is a component that is called upon to act as a gateway to access the user's personal imaging repository" and argue that

[i]n contrast, Epstein's "viewer" is merely a program that is used by the user to display images. It is not used to "retrieve" imaging data for a network-based notarization service and further is not used to retrieve such data from a "personal imaging repository." Indeed, because it is the author who is viewing the image, no such "imaging extension" is necessary. In other words, the author already knows the location of the image and already has authorization to access to it.

Reply Br. 8-9. Appellants have not demonstrated that the recited “imaging extension,” when given its broadest reasonable interpretation consistent with Appellants’ disclosure, would have been understood as necessarily having the capability of performing an authorization function.

CONCLUSIONS REGARDING THE INDEPENDENT CLAIMS

Appellants have not demonstrated that the Examiner erred in finding that Epstein:

- (1) discloses “network-based notarization service” “retrieving imaging data on behalf of a user”;
- (2) retrieves imaging data from “the user’s personal imaging repository”; and
- (3) retrieves imaging data “via an imaging extension.”

We are therefore affirming the anticipation rejection of claim 1 and the anticipation rejection of independent claims 13 and 21, which Appellants treat as standing or falling with claim 1.

THE DEPENDENT CLAIMS REJECTED FOR ANTICIPATION

Claims 5 and 17⁸ specify that the imaging extension comprises “part of a user browser.” Epstein does not employ the term “browse” or “browser.” The Examiner contends that Epstein’s viewer satisfies the following definition of “browser” from *Computer Science*: “A program that

⁸ Claim 17 is incorrectly identified as claim 13 at page 9 of the Reply Brief.

accesses and displays files and other data available on the Internet and other networks' (taken from Answers.com)." Answer 10-11. Appellants do not dispute this definition, instead noting the Examiner's finding (Answer 10) that the viewer is a browser and arguing that "Epstein's viewer cannot be interpreted as a browser *and* 'part of' a browser at the same time." Reply Br. 9. This argument is unconvincing because the term "part of" as recited in the claim means "at least part of" rather than "only part of" and thus permits the "imaging extension" to be read on Epstein's viewer in its entirety. Also, Appellants have not explained why the term "imaging extension" cannot be applied to only part of Epstein's viewer.

As for claims 6 and 18, which specify that "the imaging extension comprises part of the network-based notarization service," Appellants have not persuaded us that the Examiner erred in reading the recited "network-based notary service" on all or a part of Epstein's server, notary, and viewer, of which the Examiner reads the imaging extension on the viewer.

Claims 10, 20, and 23 specify that "electronically notarizing imaging data comprises generating a notarization certificate." The Examiner reads the notarizing certificate on the "notary's image signature" that is described at Epstein's column 5, lines 1-7, as being appended to the image (i.e., condensation image). Answer 12. This appending operation is depicted as step 196 in Figure 2c. Appellants argue that "mere appending of data to an image does not result in the generation of a 'certificate.'" In particular, no separate document, image, or file is generated through such appending." Reply Br. 10. This argument is unpersuasive for two reasons. First, the

Examiner is reading the claimed “notarization certificate” on the notary’s image signature rather than the result of combining the notary’s image signature with the condensation image. Second, Appellants’ argument is not supported by a definition of “certificate” that precludes it from being read on either the “notary’s image signature” or on result of combining it with the condensation image.

For the foregoing reasons, we affirm the anticipation rejection with respect to argued dependent claims 5, 6, 10, 17, 18, 20, and 23 and also with respect to unargued claims 7-9, 11, 12, 19, 22, and 29-31.

THE DEPENDENT CLAIMS REJECTED FOR OBVIOUSNESS

Claims 24 and 25, which depend on claim 1, stand rejected for obviousness over Epstein in view of Schreiber. Claim 24 specifies that the imaging extension comprises application programming instructions (APIs). Schreiber discloses a method and system for enabling a user to view protected image data using his web browser without being able to copy that data. Schreiber, col. 3, ll. 2-4. The Examiner relies on the passage at column 18, lines 19-38, which explains that a user is prevented from using WindowsTM API functions, such as BitBlt, StretchBlt, PlgBlt, GetPixel, and GDI32, to copy protected image data. *Id.* at col. 18, ll. 19-24. This is accomplished by including software within the user’s web browser that substitutes other functions for those WindowsTM API functions. *Id.* The substitute BitBlt function includes special logic that serves to supply substitute pixel data instead of protected image data so that the data that is

copied to the user's clipboard is different from the raw pixel data of protected images. *Id.* at col. 18, ll. 28-34. For example, the special logic "can compose watermarks and/or a text message onto protected image pixel data, or it can encrypt protected image pixel data, or it can supply a completely white image instead of a protected image." *Id.* at col. 18, ll. 34-38.

We find that the foregoing passage in Schreiber constitutes a teaching that it was known that standard WindowsTM browsers include APIs for retrieving image data for display. Because, as previously noted, Epstein explains that the viewer may be any equipment that allows the image to be played to the user (Epstein, col. 5, ll. 21-24) and because Epstein stores the imaging data in a server, we conclude that it would have been obvious in view of Schreiber to implement Epstein's viewer as a WindowsTM browser employing APIs for retrieving and displaying image data from Epstein's server and are therefore affirming the rejection of claim 24. Thus, we are unpersuaded by Appellants' argument that no motivation exists for combining the teachings of Epstein and Schreiber. Reply Br. 12.

Claim 25, which depends on claim 5, specifies that "content is downloaded from the network-based notarization service to the user browser, the content comprising generic access instructions that call upon the imaging extension to access the user's personal imaging repository." The Examiner found that Schreiber teaches the well-known technique of accepting a generic command to access information (i.e., copying) and performing a most specific task (i.e., applying special logic such as adding a

watermark) and concluded that it would have been obvious to use these types of generic commands to access the personal image repository of Epstein. Answer 14. Appellants argue that even if, as argued by the Examiner, Epstein's "viewer" comprises the claimed "user browser," the Examiner has not explained how "content" including the "generic access instructions" will be downloaded to that viewer, as required by the claim. Reply Br. 12. This argument is unpersuasive because Appellants have not asserted that, let alone explained why, Epstein's viewer, when implemented as a WindowsTM browser having APIs for retrieving imaging data from the server (per the above discussion of claim 24), will not operate in the claimed manner. We are therefore affirming the rejection of claim 25.

We are also affirming the obviousness rejection of claims 26-28, which are not separately argued. *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

DECISION

The rejection of claims 21-23 under 35 U.S.C. § 101 is reversed.

The rejection of claims 1, 5-13, 17-23, and 29-31 under 35 U.S.C. § 102(e) for anticipation by Epstein is affirmed.

The rejection of claims 24 and 25 under § 103(a) for obviousness over Epstein in view of Schreiber is affirmed, as are the rejection of claims 26 and 27 under § 103(a) for obviousness over Epstein in view of Braam and the rejection of claim 28 under § 103(a) for obviousness over Epstein in view of Natarajan.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136. *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

babc

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